

R E M A R K S

Claims 1 to 9 and 14 to 20 as set forth in Appendix I of this paper are now pending in this case.

Claim 11 has been canceled in light of the Examiner's final restriction requirement. New Claims 17 to 20 have been added to further bring out some of the subsidiary embodiments of the subject matter defined in Claim 2. New Claim 17 accordingly combines the requirements of Claims 2 and 4, and new Claims 18 and 19 further specify the embodiments of Claim 17 corresponding to Claims 6 and 8. The embodiments defined in new Claim 20 are disclosed on page 6, indicated lines 22 to 43, of the application. No new matter has been added.

In light of the foregoing and the attached it is respectfully requested that the restriction requirement be withdrawn.

The Examiner has rejected Claims 1 and 3 to 9 under 35 U.S.C. §103(a) as being unpatentable in light of the disclosure of *Yamanaka et al.* (JP 10/095,771). In this context, the Examiner takes the position that applicants' compounds (I) are homologs of the compounds disclosed by *Yamanaka et al.* because applicants' compounds (I) differ from the compounds addressed by *Yamanaka et al.* in the $-Y(R_p)^3-$ moiety which links the oxime carbon of applicants' compounds to the cyclic group A and which *inter alia* represents a methylene group.

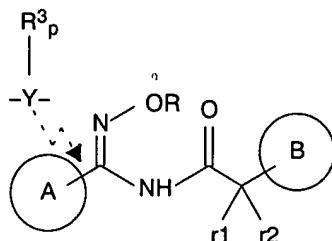
It is respectfully submitted that the mere fact that two compounds differ in a methylene group is not deemed to be sufficient to qualify the two compounds as "homolog". In accordance with the pertinent holdings of the Court in this respect, two compounds are homologs where an alkyl chain is reduced or extended by a methylene group¹), and situations where the hydrogen of a peripheral $-NH-$ or a peripheral $aryl-H$ are replaced by methyl are viewed as comparable²).

In contrast to the facts underlying the respective holdings of the Court, the $-Y(R^3)_p-$ moiety of applicants' compounds (I) is, relative to the structures taught by *Yamanaka et al.*, positioned within the core of the structure and in a particular position between the

1) Compare, for example, *In re Henze*, 181 F.2d 1395, 85 USPQ 261 (CCPA 1950); *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977); *In re Hoke*, 560 F.2d 436, 195 USPQ 148 (CCPA 1977); *In re Shetty*, 566 F.2d 81, 195 USPQ 753 (CCPA 1977).

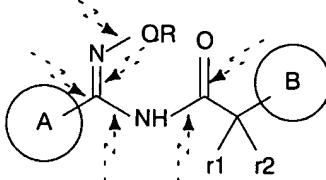
2) For example, *In re Papesch*, 315 F.2d 381, 137 USPQ 42 (CCPA 1963), *In re Wagner*, 371 F.2d 877, 152 USPQ 552 (CCPA 1967); *In re Ackermann*, 444 F.2d 1172, 170 USPQ 340 (CCPA 1971).

carbon atom of an oxime group and the carbon atom of the cyclic moiety as schematically illustrated in the following representation of **Yamanaka et al.**'s generic formula:



While it might be possible to assume that no significant change in a compound's activity will be observed when the structure of the compound is modified with regard to the length of an alkyl chain or by introducing a peripheral methyl group, the structural change which is necessary to arrive at applicants' compounds (I) based on the compounds of **Yamanaka et al.** is not deemed to be quite as trivial.

On the one hand, the insertion of applicants' moiety $-Y(R^3)_p-$ into the structure of **Yamanaka et al.**'s formula interrupts a conjugated electron system which is formed in the compounds of **Yamanaka et al.** by the $C=N$ -bond of the oxime and the heteroaromatic ring represented by "A". On the other hand, and in accordance with the Examiner's presumption that any bond may be replaced by a methylene group, the particular position in which applicants' moiety $-Y(R^3)_p-$ has to be inserted into the structure of **Yamanaka et al.**'s formula to arrive at applicants' formula (I) is merely one out of numerous possible positions some of which are indicated by the arrows in the following representation of **Yamanaka et al.**'s generic formula:



Obviousness within the meaning of Section 103(a) requires more than the mere possibility to modify the teaching of a prior art reference in the manner which is necessary to arrive at the claimed subject matter³). To render a claimed invention obvious within the meaning of Section 103(a) the reference also has to provide some teaching or suggestion which would motivate a person of ordinary skill in the art to make the particular modification which results in the claimed com-

3) For example, In re Gordon, 733 F.2d 900, 221 USPQ 1125 (CAFC 1984); see also, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985).

bination⁴). Where the motivating teaching or suggestion is not found in the prior art reference, any modification of the prior art which is possible is equally likely and the reference provides no more than an invitation to make and try out each of the possible modifications. "Obvious to try" is, however, not a proper basis for finding that a claimed invention is unpatentable under Section 103(a)⁵). A focus on the particular modification which results in the claimed invention under those circumstances would have to be based on information which is gleaned from the applicant's disclosure, cf. would have to be regarded as being based on hindsight⁶).

The disclosure of **Yamanaka et al.** cannot be taken to suggest the introduction of a group corresponding to applicants' moiety -Y(R³)_p- in any one of the positions pointed out by the arrows in the foregoing representation of **Yamanaka et al.**'s formula, and clearly fails to suggest or imply the introduction of a moiety -Y(R³)_p- in the specific position which it takes in applicants' formula (I). The disclosure of **Yamanaka et al.** is, therefore, not deemed to be sufficient to motivate a person of ordinary skill in the art to do what applicants' have done, and cannot be taken to render applicants' invention *prima facie* obvious within the meaning of Section 103(a). Favorable reconsideration of the Examiner's position and withdrawal of the rejection based on the teaching of **Yamanaka et al.** is therefore respectfully solicited.

The Examiner has rejected Claim 16 under 35 U.S.C. §112, ¶1, contending that applicants' disclosure is insufficient to enable a person of ordinary skill in the art to employ the compounds (I) for controlling all harmful fungi. In this context, the Examiner takes the position that the state of the art does not support that it is possible to draw a conclusion that all harmful fungi can be controlled merely based on results obtained in the evaluation of two phytotoxic fungi. Applicants respectfully disagree with the Examiner's position.

4) In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438, 1442 (CAFC 1991). See also In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (CAFC 1994); In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (CAFC 1992).

5) Ie. Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (CAFC 1989) where the Court held that an invention was merely "obvious to try" if the prior art gives either no indication of which parameters are critical or no direction as to which of the many possible choices is likely to be successful.

6) In re Dow Chemical Co., 837 F.2d 469, 5 USPQ2d 1529 (CAFC 1988)

Applicants herewith enclose pertinent copies of a number of representative U.S. patents relating to fungicidal ingredients⁷). The respective copies corroborate that it is not only common practice in the pertinent art but also well accepted to draw a conclusion on the activity against all harmful fungi based on investigations of one, two or three representatives of such fungi⁸). The Examiner's remarks on the state of the art are therefore not deemed to be well taken⁹). Moreover, applicants' Claim 16 sets forth that the compound (I) be applied in an effective amount and applicants' disclosure further provides numerical values for effective amounts¹⁰). Based on the information which is given by applicants, no more than routine experimentation is necessary for a person having ordinary skill in the art to successfully use the method which is defined in applicants' Claim 16¹¹). It is therefore respectfully requested that the rejection of Claim 16 under Section 112, ¶1, be withdrawn. Favorable action is solicited.

REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a three month extension of time be granted in this case. A check for the \$950.00 fee is attached.

7) US 6,420,605 (complete copy); US 6,127,570 (cover page and last three pages); US 5,994,380 (complete copy); US 5,883,250 (cover page and last five pages); US 5,206,232 (complete copy)

8) US 6,420,605 reports test results for one fungus (col. 11, indicated line 35 et seq.) and refers in Claim 5 (col. 12, indicated line 51 et seq.) to the control of "harmful fungi"; US 6,127,570 reports test results for one fungus (col. 15, indicated line 18 et seq.) and refers in Claim 8 (col. 18, indicated line 56 et seq.) to the control of a "fungus or fungal plant disease"; US 5,994,380 reports test results for two fungi (col. 12, indicated line 17 et seq.) and refers in Claim 39 (col. 19, indicated line 10 et seq.) to the control of a "fungus infection"; US 5,883,250 reports test results for three fungi (col. 106, indicated line 30 et seq.) and refers in Claim 5 (col. 114, indicated line 24 et seq.) to the control of "fungi"; and US 5,206,232 reports test results for two fungi (col. 6, indicated line 1 et seq.) and refers in Claim 6 (col. 8, indicated line 27 et seq.) to the control of "fungi".

9) Note In re Armbruster, 512 F.2d 676, 185 USPQ 152 (CCPA 1975), which holds that doubt of the Office concerning assertions made by applicant must be supported by acceptable evidence or reasoning.

10) See page 25, indicated lines 1 to 7, of the application.

11) Note In re Marzocchi, 439 F.2d 220, 169 USPQ 367 (CCPA 1971), which holds that Section 112, ¶1, requires no more than objective enablement, and that it is of no importance how such a teaching is set forth, cf. by use of illustrative examples or by broad terminology.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,
KEIL & WEINKAUF



Herbert B. Keil
Reg. No. 18,967

1350 Connecticut Ave, N.W.
Washington, D.C. 20036
(202) 659-0100

Encl.: THE LISTING OF CLAIMS (Appendix I)

US 6,420,605 (complete copy)
US 6,127,570 (cover page and last three pages)
US 5,994,380 (complete copy)
US 5,883,250 (cover page and last five pages)
US 5,206,232 (complete copy)

HBK/BAS